

**REMARKS**

This Amendment is responsive to the Office Action dated May 24, 2006. Applicant has not amended any claims by this Response. Claim 22 is cancelled. Claims 1-21 and 23-35 are pending. Applicant respectfully requests reconsideration of the application in light of the following remarks.

**Claim Rejections Under 35 U.S.C. § 103**

In the Office Action, the Examiner rejected claims 1-4, 7-9, 10-11, 21, 23-28 and 30-35 under 35 U.S.C. 103(a) as being unpatentable over Wakefield II (US 5,961,561) in view of Barker et al. (US 6,314,422).

Claims 12-20 were rejected under 35 U.S.C. 102(b) as being anticipated by Doherty et al. (US 6,735,293) in view of Barker et al (US 6,314,422) (Note: Applicant assumes the Examiner intended this rejection to be under 35 U.S.C. 103).

Claims 21 and 23-24 were rejected under 35 U.S.C. 102(b) as being anticipated by Koropitzer et al (US 5,694,323) in view of Barker et al (US 6,314,422) (Note: Applicant assumes the Examiner intended this rejection to be under 35 U.S.C. 103).

Claims 5 and 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wakefield II (US 5,961,561) in view of Barker et al. (US 6,314,422) in view of Doherty et al. (US 6,735,293).

***Claims 1-4, 7-9, 10-11, 21, 23-28 and 30-35***

The invention as recited in amended independent claim 1 is directed to a method for providing customized advisory information to a field service provider. Advisory information, formatted in a plurality of languages, is associated with a customer account identifier input by the field service provider. Customized advisory information formatted to a language associated with the field service provider is presented to the field service provider through a network device. Independent claims 21 and 25 recite similar subject matter in system and computer readable medium claim formats, respectively.

The Examiner relies on a combination Wakefield II and Barker et al. to reject independent claims 1, 21 and 25. Applicant respectfully submits, however, that there is no teaching, suggestion or motivation to modify the references or to combine reference teachings in the manner suggested by the Examiner as required to establish a *prima facie* case of obviousness under 35 U.S.C. §103. Nowhere in either Wakefield II or Barker et al. can there be found any motivation whatsoever to combine the two references in the way the Examiner suggests.

Wakefield, II, for example, is directed to a software program (referred to in Wakefield, II as a "TDP system") for remotely monitoring and controlling operation of an electric or motorized wheelchair. In contrast to claims 1, 21 and 25 which require the selection of advisory information that is "customized" to the language of a specific field service provider, Wakefield, II only teaches the presentation of advisory information to users of the TDP system in a single language – English (see, for example, FIG. 6 of Wakefield II). That is, the TDP system of Wakefield II displays information in the English language regardless of the user's preferred language. Consequently, Wakefield II fails to teach or suggest the selection of advisory information formatted to a language associated with a requesting field service provider.

By failing to teach or suggest storage of advisory information in multiple languages, Wakefield, II lacks any motivation whatsoever for modifying its TDP system to include such a feature. That is, one of skill in the art reading Wakefield, II would not have realized the desirability of modifying the TDP system to provide for the presentation of advisory information to field service providers in a language specific to each provider. As such, one of skill in the art would have no reason to look to the Barker et al. reference, which is in an entirely different field of endeavor, for a means of providing such customized advisory information.

Barker et al. fails to provide the motivation missing from Wakefield II to combine the two references in the way suggested by the Examiner.

Barker et al. teaches a method for softlinking between documents in a vehicle diagnostic system. Various technician context information, such as preferred language, is maintained to manage operation of "sessions," the period of time during which a technician is working on a particular vehicle. Applicant respectfully submits that one of skill in the art reading Barker et al. would not have realized the desirability of using its preferred language information in a system such as that described by Wakefield II, which is expressly concerned only with wheelchairs.

Thus, there is no motivation to be found in the cited references Wakefield II or Barker et al., either alone or in combination, to combine the reference teachings in the manner suggested by the Examiner. As a result, the cited combination of these three references would not provide a basis for modification in the direction of the present invention without the facilitation of impermissible hindsight based on a reading of the present application.

Accordingly, without access to Applicants' own disclosure, one of ordinary skill in the art would have had no appreciation of the desirability of the modifications set forth by the Examiner. Rather, Applicants respectfully submit that the Examiner is improperly using Applicants' invention as a road map to assemble components from the alleged combination of Wakefield II and Barker et al. Such use of impermissible hindsight is improper for finding a *prima facie* case of obviousness.<sup>1</sup>

In summary, the Examiner's conclusion of obviousness and particularly the cited motivation to modify the system of Wakefield II in view of the teachings of Barker et al. is unsupported by any substantial evidence in the record. For at least these reasons, the Office Action has failed to set forth a *prima facie* case of obviousness of Applicant's claims 1, 21 and 25 and, by virtue of their dependency, any of their respective dependent claims. Applicant therefore respectfully requests that the rejection of claims 1-4, 7-9, 10-11, 21, 23-28 and 30-35 under 35 U.S.C. 103(a) as being unpatentable over Wakefield II in view of Barker et al. be withdrawn.

### ***Claims 12-20***

As noted above, Applicant notes that the rejection of claims 12-20 in paragraph 3 of the Office Action are listed as being under "35 U.S.C. 102(b)." Applicant assumes, however, that the Examiner intended this rejection to be under 35 U.S.C. 103, as it is a rejection made using a combination of references, and will therefore address the rejection accordingly.

Like claims 1, 21 and 25, claim 12 recites a method in which advisory information is provided to a field service provider in a language specific to the provider. The information is

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<sup>1</sup> See *Interconnect Planning Corp. v. Feil*, 227 USPQ 543 (CAFC 1985); see also *In re Fine*, 5 USPQ2d 1596, 1598 (CAFC 1988); see also *In re Gorman*, 18 USPQ 2d 1885, 1888 (CAFC 1991); see also *Al-Site Corp. v. VSI International, Inc.*, 50 USPQ2d 1161, 1171 (CAFC 1999).

presented to the field service provider as the field service provider is in transit between a first destination facility and a second destination facility.

Neither Doherty et al. nor Barker et al. provide any motivation to combine the references in the manner suggested by the Examiner, as required to establish a *prima facie* case of obviousness under 35 U.S.C. 103.

Doherty et al. teaches a system for providing reliable service in the telecommunications industry. The Services Provisioning and Assurance system (SPA) facilitates installation and repair of equipment by automating some aspects of the installation process and then monitoring faults generated by malfunctioning customer equipment. In some cases, the SPA is able to repair faults on its own. Otherwise, the SPA sends a message describing the needed service to a field service provider via electronic mail or an alphanumeric page.

Doherty et al. does not disclose providing advisory information in a customized language format associated with a given field service provider. Rather, Doherty et al. discloses only transmitting information via either an alphanumeric page or electronic mail. The information that is transmitted is the same in either case; it is not stored or relayed in a language specific to the field service provider. As a result, one of skill in the art reading Doherty et al. would not have realized the desirability to modify the its system to provide for the presentation of customized advisory information to field service providers in a language specific to each provider, and would not have provided any motivation to look to the Barker et al. reference for such a feature.

In addition, Barker et al. does not disclose, teach or suggest use of its preferred language feature with a system in which information is presented to the field service provider as the field service provider is in transit. As a result, Barker et al. is insufficient to overcome the lack of disclosure in Doherty et al., and one of skill in the art reading Barker et al. would not have appreciated the desirability of incorporating its preferred language feature into a system in which information is presented to the field service provider as the field service provider is in transit as recited in claim 12.

As a result of the above-described deficiencies in the teachings of Doherty et al. and Barker et al., the cited combination of these references would not provide a basis for

modification in the direction of the present invention without the facilitation of impermissible hindsight based on a reading of the present application.

Accordingly, without access to Applicants' own disclosure, one of ordinary skill in the art would have had no appreciation of the desirability of the modifications set forth by the Examiner. Rather, Applicants respectfully submit that the Examiner is improperly using Applicants' invention as a road map to assemble components from the alleged combination of Doherty et al. and Barker et al. Such use of impermissible hindsight is improper for finding a *prima facie* case of obviousness.<sup>2</sup>

In summary, the Examiner's conclusion of obviousness to modify the system of Doherty et al. in view of the teachings of Barker et al. is unsupported by any substantial evidence in the record. For at least these reasons, the Office Action has failed to set forth a *prima facie* case of obviousness of Applicant's claim 12 and, by virtue of their dependency, dependent claims 13-20. Applicant therefore respectfully requests that the rejection of claims 12-20 under 35 U.S.C. 103 as being unpatentable over Doherty et al. in view of Barker et al. be withdrawn.

#### ***Claims 21 and 23-24***

Claims 21 and 23-24 were rejected under 35 U.S.C. 102(b) as being anticipated by Koropitzer et al. in view of Barker et al. (Note: Applicant assumes the Examiner intended this rejection to be under 35 U.S.C. 103).

Koropitzer generally describes a process and system for monitoring the amount of revenue generated by and the repair history for remote laundromats having laundry machines. Koropitzer teaches that monitoring cash collections can lead to various types of analyses regarding the financial aspects of operating laundromats and that monitoring repair history can indicate whether a malfunctioned machine has been repaired. Such monitoring is administered by a network having a main controller unit (MCU) and multiple site controller units (SCU). The SCU's are located at each of the remote laundromats and collect information regarding cash collections and repair history for communication to the MCU. In this regard, the location of the MCU is referred to in Koropitzer as a "monitoring site" (see Koropitzer, at Col. 12, line 60).

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<sup>2</sup> See *Interconnect Planning Corp. v. Feil*, 227 USPQ 543 (CAFC 1985); see also *In re Fine*, 5 USPQ2d 1596, 1598 (CAFC 1988); see also *In re Gorman*, 18 USPQ 2d 1885, 1888 (CAFC 1991); see also *Al-Site Corp. v. VSI International, Inc.*, 50 USPQ2d 1161, 1171 (CAFC 1999).

Claim 21 discloses a database storing the generated advisory information in a plurality of language formats. Further, claim 21 discloses a means for selecting the language in which to format information for the field service provider based on the provider identifier. In this way, the advisory information is customized to each field service provider. Claim 21 as amended also includes the language of claim 5, in which advisory information is presented to a field service provider while the field service provider is in transit.

Koropitzer does not disclose a database storing the generated advisory information in a plurality of language formats. The MCU communicates with each SCU through a communication line, typically a phone line, which is connected to a modem. The MCU and SCU's communicate through a common, fixed protocol. There is no need to store advisory information in a plurality of language formats because communication at this level is between two compatible devices. Koropitzer does not teach or suggest storing information in a plurality of languages. Further, Koropitzer does not disclose a means for selecting advisory information from the database for presentation to the field service provider, wherein the selecting means selects the advisory information in one of the plurality of language formats based on the provider identifier. Because Koropitzer does not store advisory information in a plurality of languages, there is no ability or need to select the language in which to display advisory information. As a result, one of skill in the art reading Koropitzer would not have realized the desirability to modify the its system to provide for the presentation of customized advisory information to field service providers in a language specific to each provider, and would not have provided any motivation to look to the Baker et al. references for such a feature.

For at least the foregoing reasons, independent claim 21 is believed allowable over the combination of Koropitzer and Barker et al. Claims 22-24 depend directly or indirectly from claim 21 and, consequently dependent claims 23 and 24, are also believed allowable.

***Claim 5 and 29***

To reject claims 5 and 29, the Examiner relies on a three reference combination of Wakefield II, Barker et al. and Doherty et al. Applicant respectfully submits that none of the cited references provide any motivation whatsoever to combine them in the manner suggested by the Examiner.

As discussed above, Wakefield II provides no motivation to combine its TDP system with the preferred language feature of Barker et al. Likewise, Wakefield II does not teach or suggest presentation of the customized advisory information while the field service provider is in transit, as recited in claims 5 and 29. Rather, Wakefield II merely describes presentation of advisory information on a remote TDP system (see Wakefield II at col. 4, lines 23-25, for example). By failing to teach or suggest presentation of the customized advisory information while the field service provider is in transit, Wakefield, II lacks any motivation whatsoever for modifying its TDP system to include such a feature. That is, one of skill in the art reading Wakefield, II would not have realized the desirability of modifying the TDP system to provide for the presentation of advisory information while the field service provider is in transit. As such, one of skill in the art looking at the Wakefield II reference would have no reason to look to the Doherty et al. reference, which is in an entirely different field of endeavor, for a means of providing such customized advisory information.

In addition, neither Barker et al. nor Doherty et al. provide the motivation missing from Wakefield II to combine all three references in the way suggested by the Examiner.

Barker et al., as described above, teaches a method for softlinking between documents in a vehicle diagnostic system. Various technician context information, such as a preferred language, is maintained to manage operation of “sessions,” the period of time during which a technician is working on a particular vehicle. A session begins when the technician, having logged into the system, connects a diagnostic tool to a new vehicle to be serviced (see Barker et al., col. 4, line 66 to col. 5, line 1). In this sense, the Barker et al. system is used only at the physical location where service to a vehicle actually takes place. As such, Barker et al. does not teach or suggest presentation of customized advisory information while the field service provider is in transit. Thus, one of skill in the art reading Barker et al. would not have realized the desirability of modifying the its system to provide for presentation of the customized advisory information while the field service provider is in transit, as required by claims 5 and 29, and would not have provided any motivation to look to the Doherty et al. references for such a feature.

Doherty et al. teaches a system for providing reliable service in the telecommunications industry. The Services Provisioning and Assurance system (SPA) facilitates installation and

repair of equipment by automating some aspects of the installation process and then monitoring faults generated by malfunctioning customer equipment. In some cases, the SPA is able to repair faults on its own. Otherwise, the SPA sends a message describing the needed service to a field service provider via electronic mail or an alphanumeric page.

Doherty et al. does not disclose providing advisory information in a customized language format associated with a given field service provider. Rather, Doherty et al. discloses only transmitting information via either an alphanumeric page or electronic mail. The information that is transmitted is the same in either case; it is not stored or relayed in a language specific to the field service provider. As a result, one of skill in the art reading Doherty et al. would not have realized the desirability to modify the its system to provide for the presentation of customized advisory information to field service providers in a language specific to each provider, and would not have provided any motivation to look to the Barker et al. references for such a feature.

Thus, there is no motivation to be found in any of the cited references Wakefield II, Barker et al. or Doherty et al. to combine the teachings of these three references in the manner suggested by the Examiner. As a result, the cited combination of these three references would not provide a basis for modification in the direction of the present invention without the facilitation of impermissible hindsight based on a reading of the present application.

Accordingly, without access to Applicant's own disclosure, one of ordinary skill in the art would have had no appreciation of the desirability of the modifications set forth by the Examiner. Rather, Applicant respectfully submits that the Examiner is improperly using Applicant's invention as a road map to assemble components from the alleged three-reference prior art combination of Wakefield II, Barker et al. and Doherty et al. Such use of impermissible hindsight is improper for finding a *prima facie* case of obviousness.<sup>3</sup>

In summary, the Examiner's conclusion of obviousness and particularly the cited motivation to modify the system of Wakefield II in view of the teachings of Barker et al. and Doherty et al. is unsupported by any substantial evidence in the record. For at least these reasons,

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<sup>3</sup> See *Interconnect Planning Corp. v. Feil*, 227 USPQ 543 (CAFC 1985); see also *In re Fine*, 5 USPQ2d 1596, 1598 (CAFC 1988); see also *In re Gorman*, 18 USPQ 2d 1885, 1888 (CAFC 1991); see also *Al-Site Corp. v. VSI International, Inc.*, 50 USPQ2d 1161, 1171 (CAFC 1999).

the Office Action has failed to set forth a prima facie case of obviousness of Applicant's claims 5 and 29. Withdrawal of this rejection is therefore respectfully requested.

### CONCLUSION

All claims in this application are in condition for allowance. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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